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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,992	11/05/1999	JOSEPH M. CANNON	90-81-39	4633

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EXAMINER

NGUYEN, DUC MINH

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/434,992

Applicant(s)

CANNON ET AL.

Examiner

Duc Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 8, 11, 21, 26, 29, 31, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 8, 11, 21, 26, 29, 31, 33, 34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The amendment filed 2/17/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: a processor adapted to store said received caller id data into said caller id log only if said incoming call went unanswered by a person, and only when said caller id log is more full than a predetermined threshold.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The added material which is not supported by the original disclosure is as follows: a processor adapted to store said received caller id data into said caller id log only if said incoming call went unanswered by a person, and only when said caller id log is more full than a predetermined threshold.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 8, 11, 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (5,859,903).

Consider claims 1, 11, 21. Lee teaches a telephone device (key telephone) comprising current caller id memory (temporary buffer) to receive incoming caller id data associated with an incoming call (temporary buffer; col. 4, ln. 56-67); a module (CPU 10) to determine if a telephone call was answered by a person; a caller id log (memory 12) to contain a plurality of caller id data; a processor adapted to store the received caller id data into the caller id log if the incoming call went unanswered by a person (col. 4, ln. 56 to col. 5, ln. 29; figs. 1-2).

Consider claim 8. Lee teaches a telephone device (key telephone) comprising current caller id memory (temporary buffer) to receive incoming caller id data associated with an incoming call (temporary buffer; col. 4, ln. 56-67); a module (CPU 10) to determine if a telephone call was answered by a person; a caller id log (memory 12) to contain a plurality of caller id data; a processor adapted to store the received caller id data into the caller id log if the incoming call went unanswered by a person (col. 4, ln. 56 to col. 5, ln. 29; figs. 1-2). Note that

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the limitations: and only when said caller id log is more full than a predetermined threshold, will not be considered since it's a new matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (5,859,903).

Consider claims 5, 26. Lee teaches a telephone device (key telephone) comprising current caller id memory (temporary buffer) to receive incoming caller id data associated with an incoming call (temporary buffer; col. 4, ln. 56-67); a module (CPU 10) to determine if a telephone call was answered by a person; a caller id log (memory 12) to contain a plurality of caller id data; a processor adapted to store the received caller id data into the caller id log if the incoming call went unanswered by a person (col. 4, ln. 56 to col. 5, ln. 29; figs. 1-2). Lee does not teach that the processor adapted to store only a portion but not all of the received caller id data into the caller id log if the incoming call went unanswered by a person. However, fig. 4 illustrates a table of a caller id abandoned buffer. It is clear that the data stored in the table is user-defined data. Therefore, only a portion of the data or all parts of the data can be stored depends on the user-defined data. It appears that the selecting only a portion of the data or all parts of the data would depend more upon the choice of the manufacturer, and the convenience

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and availability of the machines and tools necessary to store the caller id information, than on any inventive concept.

8. Claims 29, 31, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (5,859,903) in view of Lim et al (5,883,942).

Consider claim 29. Lee does not teach the caller ID storage decision is made in response to user input and affects caller ID data already stored.

Lim further teaches the caller ID storage decision is made in response to user input and affects caller ID data already stored (col. 6, ln. 34 to col. 8, ln. 13, especially, col. 7, ln. 10-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lim into the teachings of Lee in order to save memory space, since the memory space is small and limited.

Consider claim 31. Lee teaches a telephone device (key telephone) comprising current caller id memory (temporary buffer) to receive incoming caller id data associated with an incoming call (temporary buffer; col. 4, ln. 56-67); a module (CPU 10) to determine if a telephone call was answered by a person; a caller id log (memory 12) to contain a plurality of caller id data; a processor adapted to store the received caller id data into the caller id log only if the incoming call went unanswered by a person (col. 4, ln. 56 to col. 5, ln. 29; figs. 1-2). Lee does not teach determining that a caller id log is more full than a predetermined threshold; and if the caller id log is more full than the predetermined threshold, storing the received caller id into the caller id log only if the incoming telephone call went unanswered by a person.

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Lim teaches determining that a caller id log is more full than a predetermined threshold (col. 6, ln. 20-29). Lee teaches store the received caller id data into the caller id log only if the incoming call went unanswered by a person (col. 4, ln. 56 to col. 5, ln. 29; figs. 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Lim and the teachings of Lee in order to save memory space, since the caller id memory space is small and limited.

Consider claim 33. Lim further teaches keypad (user interface 22).

9. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (5,859,903).

Consider claim 34. Lee does not teach storing a message associated with the incoming call.

Tverskoy teaches storing a message associated with the incoming call (col. 3, ln. 13-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Tverskoy into the teachings of Lee in order to provide an integrated caller id/ voice mail device that positively identifies the calling party.


Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is 703-308-7527. The examiner can normally be reached on 6:00AM-2:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Duc Nguyen
Primary Examiner
Art Unit 2643

3/18/04